

REMARKS

Claims 1-14 and 31 are pending herein. Claims 1-6, 13 and 14 have been withdrawn from consideration by the PTO as being drawn to non-elected species. Claims 15-30 have been cancelled without prejudice or disclaimer as being drawn to a non-elected invention. Claim 7 has been amended as supported by Figs. 18-22, for example. Claims 8-11 have been amended to depend from new claim 31 (discussed below) in addition to clarifying the language of those claims.

New claim 31 is added hereby. New claim 31 recites substantially the same subject matter as pending independent claim 7, but differs in the recitation of a tube for receiving a pipette. Accordingly, the "tube for receiving a pipette" limitation has been deleted from original claim 7 and is now recited in new claim 31.

1. Applicants affirm the provisional election to prosecute claims 1-14. Claims 15-30 have been withdrawn from consideration as being drawn to a non-elected invention, and thus have been cancelled without prejudice or disclaimer. Applicants reserve the right under 35 USC §121 to file a divisional application for non-elected claims 15-30.

2. The PTO objected to the drawings in paragraph 2 of the Office Action. The Office Action states that the scale, projection and filter structures recited in claims 9-11, respectively, are not shown in the drawings. However, Fig. 22 of the present application shows examples of a scale 182, projections 184 and filter 186 corresponding to the scale, projection and filter structures discussed above. Reconsideration and withdrawal of the objection to the drawings are respectfully requested.

3. Claim 9 was objected to in paragraph 3 of the Office Action. Claim 9 now recites that the scale is formed on at least a part of the tube for receiving a pipette, as suggested in the Office Action. Accordingly, withdrawal of the claim 9 objection is respectfully requested.

4. Claims 10 and 11 were rejected under §112, first paragraph in paragraph 5 of the Office Action. To the extent that this rejection might be applied against amended claims 10 and 11, it is respectfully traversed.

Amended claim 10 now recites that a plurality of projections are formed on a part of the inner wall of the tube for receiving a pipette. The projections are spaced apart and positioned on the inner wall substantially the same axial distance from the pouring port. An example of the claimed projections (i.e., projections 184) is shown in Fig. 22 and explained on page 41 of the present application. It is respectfully submitted that, upon viewing Fig. 22 and reading page 41 of the specification, skilled artisans would readily understand how to make and use the invention recited in claim 10.

Claim 11 now recites that a filter is attached to portions of the substrate and the holding section between the pouring port and the tube for receiving the pipette. The filter has a large number of openings defining an opening area on the surface of the filter. The opening area has a surface area that is not larger than an opening area of the discharge port. An example of the claimed filter (i.e., filter 186) is shown in Fig. 22 which illustrates that filter 186 is attached to holding section 160 and substrate 50 via adhesive 188, and is positioned between tube 180 and sample-pouring port 52 (please see the discussion on page 41, lines 7-13 of the present specification). It is respectfully submitted that, upon viewing Fig. 22 and reading page 41 of the specification, skilled artisans would readily understand how to make and use the invention recited in claim 11.

In view of all of the foregoing, reconsideration and withdrawal of the §112, first paragraph rejection are respectfully requested.

5. The rejection of claims 7-12 under §112, second paragraph is noted, but deemed moot in view of the rewritten claims submitted above.

6. Claims 7, 8 and 10-12 were rejected under §102(e) or, in the alternative, under §103(a) over Barth et al. in view of JP 04-327943A and Douglas et al. or Goodman et al. or Seto et al. These rejections are respectfully traversed.

It is unclear to Applicants whether only Barth et al. or multiple references are being applied under §102(e). Based on the discussion in the Office Action, it is Applicants' understanding that claims 7, 8 and 10-12 were rejected under §102(e) over Barth et al. or, in the alternative, over §103(a) over Barth et al. in view of JP '943 or Douglas or Goodman or Seto. The PTO is requested to contact the undersigned if this understanding is incorrect.

Before discussing the applied prior art, as explained above, the subject matter recited in original independent claim 7 has been split into two separate independent claims. Pending independent claim 7 and dependent claim 12 represent one claim set covering a micropipette including a holding section (e.g., holding section 160 shown in Figs. 18-20). New independent claim 31, and dependent claims 8-11, represent another claim set covering the addition of a tube (e.g., tube 180 shown in Figs. 21 and 22) that is held by holding section 160. Accordingly, new independent claim 31 will also be discussed below with respect to the above-identified §102(e)/§103(a) rejections.

With reference to Figs. 18-22 of the present application, pending independent claim 7 recites, among other things, that a holding section 160 is provided to hold a pipette 142, which supplies sample solution into a pouring port. Claim 7 has been amended to clarify that the holding section 160 is attached on an outer portion of the substrate (e.g., substrate 50A shown in Fig. 18) at or proximate a circumferential edge of a pouring port of each micropipette 34.

With reference to Fig. 21 of the present application, new pending independent claim 31 recites, among other things, that a holding section 160 is attached on an outer portion of

the substrate at or proximate a circumferential edge of a pouring port of each of the micropipettes, and includes a tube 180 for receiving a pipette 142. The applied prior art references of record (discussed below), in combination or individually, do not disclose or suggest that a separate, distinct holding section is positioned on an outer portion of the substrate, as claimed in pending claims 7 and 31.

With reference to Fig. 1C of Barth, a multiple reservoir apparatus includes a port 21, into which a biomolecular fluid is supplied. Although not explicitly stated in the Office Action, the PTO is apparently arguing that a portion of the inner circumferential surface of Barth's port 21 corresponds to the claimed holding section. As discussed above, and with further reference to Fig. 18 of the present application, pending independent claims 7 and 31 each recite that holding section 160 is "attached on an outer portion of said substrate at or proximate a circumferential edge of said pouring port...". Accordingly, holding section 160 is a separate, distinct component that is positioned on a portion of substrate 50, and is not a part of the pouring port itself. Barth does not disclose or suggest that a separate, distinct holding section is "attached" on a portion of the substrate, let alone attached on an outer portion of the substrate as claimed. For these reasons alone, the §102(e) rejection of record should be withdrawn.

The PTO is alleging that any one of JP '943, Seto, Douglas or Goodman discloses the claimed holding section. Applicants respectfully disagree. With respect to JP '943, and with reference to Fig. 1(a) of JP '943, a port 5 is in fluid communication with reservoir 12. The PTO's position appears to be that an extending portion of substrate 4, which defines the upper portion of port 5, is equivalent to the claimed holding section (see Office Action page 7). In contrast to pending independent claims 7 and 31, similar to Barth discussed above, JP '943 port 5 is not a separate, distinct component attached to a portion of substrate 4. Again,

pending claims 7 and 31 each recite that the holding section is “attached on an outer portion of said substrate...”.

Fig. 1 of Seto shows that nozzle 18, tip body 14 and annular lid member 16 form an integral pipette unit that allows for the repeated application of liquid stored in container 20. In operation, nozzle 18 provides a pump means for drawing liquid L into tip body 14, both of which are then (as a single unit along with annular lid member 16) withdrawn from container 20 and used to transfer and dispense the liquid at another location.

As can be understood from the above, Seto’s integral pipette unit does not disclose or suggest a structure that corresponds to the claimed separate, distinct holding section. Moreover, as illustrated in Fig. 1 of Seto, a portion of annular lid member 16 protrudes into container 20. Pending claims 7 and 31, however, each recite that the holding section is “attached *on* an outer portion of said substrate.” However, a portion of Seto’s annular lid member 16 is *inserted into* the mouth of container 20. Therefore, annular lid member 16 (which, again is a part of the integral pipette unit and is repeatedly removed) is not “attached on an outer portion of said substrate” (as claimed), but rather, is removably inserted into a portion of container 20.

Nor does Seto disclose a holding section that includes “a tube for receiving said pipette,” as recited in new independent claim 31. Again, Seto’s nozzle 18 and tip body 14 form the pipette unit. Accordingly, skilled laboratory professionals would understand that tip body 14 does not correspond to the claimed “tube for receiving said pipette” because tube body 14 is a part of the pipette itself. Therefore, in addition to failing to disclose or suggest the claimed holding section (discussed above), Seto also fails to disclose or suggest the claimed pipette receiving tube.

Douglas discloses a home testing kit that allows for analyte collection and analyzation using an integrated collection/analyzing unit. Fig. 1 of Douglas shows that capillary tube 2 is mounted on support member 3 above a test window or aperture 10 (shown more clearly in Fig. 5). Capillary tube 2 is specifically designed to collect a blood or body fluid sample when the extended end of the capillary tube contacts a desired location on the patient's body (see column 6, lines 5-28).

Although capillary tube 2 appears to be positioned on an outer surface of support member 3, as is the case with all of the prior art discussed above, there is no disclosure of a separate, distinct holding section that holds capillary tube 2. In contrast to Douglas, pending independent claims 7 and 31 each recite that the holding section is "attached on an outer portion of said substrate...". Again, there is no disclosure in Douglas that a separate, distinct holding section is attached on any portion of support member 3, let alone attached "at or proximate a circumferential edge of said pouring port," as claimed.

Nor does Douglas disclose or suggest the use of the claimed "tube for receiving said pipette" recited in new independent claim 31. This is so because capillary tube 2 is specifically designed to collect a blood or body fluid sample upon contacting a desired location on the patient's body, and skilled artisans would have had no reason to believe that a pipette could or should be received in capillary tube 2. Again, Douglas discloses an integrated collection/analyzing home testing unit that eliminates the need for such a pipette and pipette receiving tube.

Figs. 1 and 6a of Goodman show a self-contained assay device that includes through-hole 54, into which a specimen to be tested is introduced, and includes a receptacle 56 provided thereon. Similar to all of the applied art references discussed above, there is no disclosure in Goodman that a holding section for holding a pipette is "attached on an outer

portion of said substrate...,” as recited in each of pending claims 7 and 31. It is clear from Goodman’s drawings that no separate, distinct structure is attached on housing or cam plate 40 to hold receptacle 56.

In view of all of the foregoing, reconsideration and withdrawal of the §102(e)/103(a) rejections are respectfully requested.

7. Claim 9 was rejected under §103(a) over Barth et al. in view of JP ‘943 and Douglas or Goodman and further in view of Gautsch. Applicants respectfully submit that the arguments submitted above distinguish claim 31 from Barth, JP ‘943, Douglas and Goodman. Since Gautsch does not overcome the deficiencies of Barth, JP ‘943, Douglas and Goodman, and since claim 9 depends directly from claim 31, claim 9 is also believed to be allowable over the applied art. Reconsideration and withdrawal of this rejection are respectfully requested.

8. Claim 11 was rejected under §103(a) over Barth in view of JP ‘943 and Douglas or Goodman and further in view of Nishioka et al. Applicants respectfully submit that the arguments submitted above distinguish claim 31 from Barth, JP ‘943, Douglas and Goodman. Since Nishioka does not overcome the deficiencies of Barth, JP ‘943, Douglas and Goodman, and since claim 11 depends directly from claim 31, claim 11 is also believed to be allowable over the applied art. Reconsideration and withdrawal of this rejection are respectfully requested.

9. Claim 11 was rejected under §103(a) over Barth in view of JP ‘943 and Douglas or Goodman and further in view of Torti et al. Applicants respectfully submit that the arguments submitted above distinguish claim 31 from Barth, JP ‘943, Douglas and Goodman. Since Torti does not overcome the deficiencies of Barth, JP ‘943, Douglas and Goodman, and since claim 11 depends directly from claim 31, claim 11 is also believed to be allowable over

the applied art. Reconsideration and withdrawal of this rejection are respectfully requested.

GB 2 090 659 was included with the Office Action received from the PTO, but was not listed on the Form PTO-892 attached to the Office Action. If GB '659 was not erroneously forwarded in the Office Action, the PTO is requested to list GB '659 in a Form PTO-892.

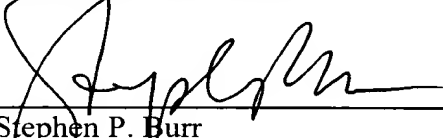
If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

April 25, 2003

Date

Respectfully submitted,



Stephen P. Burr
Reg. No. 32970

SPB/SC/tlp

BURR & BROWN
P.O. Box 7068
Syracuse, NY 13261-7068

Customer No.: 025191
Telephone: (315) 233-8300
Facsimile: (315) 233-8320